

**REMARKS**

Reconsideration of this application is respectfully requested. Claims 1-3, 22-24, 31, and 34 have been amended. Claims 4, 20, and 25 have been cancelled without prejudice or disclaimer. Upon entry of the present amendment, claims 1-3, 5, 6, 22-24, 31, and 34-35 will be under examination.

**I. Status of the Claims and Amendments**

Claim 1 has been amended to recite an “estradiol compound or a conjugated equine estrogen composition” instead of “estrogen compound.” Claim 3 has been correspondingly amended. Support for “an estradiol compound” is found throughout the specification, for example, on page 8, lines 19-20, and in a particular example (i.e., 17 $\beta$  estradiol) of original claims 3-4, 20, 22-23, and 34-35. Claim 4 has been cancelled without prejudice or disclaimer. Support for “a conjugated equine estrogen composition” is found at least in original claims 4 and 31.

Claim 2 has been amended to recite “A $\beta$ ” instead of “amyloid- $\beta$ ” for consistency with the nomenclature of claim 1. This amendment is not related to any reason related to patentability.

Claims 20 and 25 have been cancelled without prejudice or disclaimer. Consequently, the dependencies of claims 22-24, 31, and 34 have been amended. Claim 24 has also been amended to recite that “the animal exhibits Alzheimer’s disease symptoms” instead of “wherein the disease or disorder associated with amyloidosis is Alzheimer’s disease.” Support for this amendment may be found at least on page 18, lines 8-17 of the specification.

It is believed that the present amendments are in compliance with 37 C.F.R. § 1.116 since no new searching is necessary, and the present amendments are believed to place the claims in condition for allowance. No new matter is added by way of these amendments.

**II. Rejections Under 35 U.S.C. § 112, First Paragraph**

The rejection of claims 1, 2, 4-6, 20, 22-25, and 31 under 35 U.S.C. § 112, first paragraph, as lacking enablement based on various grounds, has been maintained. The rejection is respectfully traversed, and reconsideration in view of the present amendments is requested.

The Examiner states that the specification does not enable the method of claim 1 because there is no evidence that *in vivo* administration of *any estrogen compound* can reduce A $\beta$  levels without affecting sAPP levels. However, the Examiner acknowledges that this method is enabled with respect to 17 $\beta$ -estradiol. *See* Office Action at pp. 2-3. The Examiner also states that undue experimentation would be required to identify estrogen compounds that reduce A $\beta$  levels without affecting sAPP levels. Applicants maintain that the specification describes how to make and use all the estrogen compounds of the invention, and provides disclosure of pharmaceutical formulations, administration, dosage, and regimen. *See, e.g.*, page 15, line 10 through page 19, line 27.

However, in order to expedite prosecution of the present case, and without conceding the Examiner's position or the validity of the rejection, claim 1 has been amended to recite "an estradiol compound or a conjugated equine estrogen composition" instead of "an estrogen compound." Claim 3 has been amended accordingly. Claims 4, 20, and 25 have been cancelled without prejudice or disclaimer, and the dependencies of claims 22-24, 31, and 34 have been amended.

Estradiol is a species of the genus "estrogen compound" and finds support at least on page 8, lines 19-20 of the specification. The Examiner concedes that the specification is enabling for estradiol effects on A $\beta$  peptide levels without affecting the level of soluble APP (*see* Office Action at page 3). Similarly, the specification enables the use of conjugated equine estrogen compositions, which find support at least on page 8, lines 16-17 of the specification and in original claims 4 and 31. Thus, the specification provides adequate guidance for determining the amount of an estradiol compound or a conjugated equine estrogen composition that reduces A $\beta$  levels *in vivo* without affecting sAPP levels.

The Examiner also states that the specification does not disclose how to predict susceptibility to Alzheimer's Disease (AD) and how the treatment of these individuals with estrogens would delay or reduce the likelihood or ameliorating Alzheimer's Disease or other diseases involving amyloidosis. Applicants maintain that the specification expressly defines "has an increased risk of developing" and "shows a symptom of" a disease or disorder associated with amyloidosis (page 18, lines 8-17). These definitions describe subjects susceptible to developing AD, such as those with a genetic predisposition to develop amyloidosis, or those in their 70s and 80s. Thus, the specification provides adequate guidance for predicting AD susceptibility.

However, in order to expedite prosecution of the present case, claim 20 has been cancelled, and the dependencies of claims 22-24, 31, and 34 have been appropriately amended. The Examiner's statements regarding Zandi et al. (*JAMA*, 288(17):2123-29 (2002)) in the context of prevention of AD and the unpredictability of ameliorating AD are moot in view of the present amendments.

In view of the foregoing, Applicants submit that the present specification fully enables one of ordinary skill in the art to make and use the invention called for in the pending claims without undue experimentation. Thus, it is believed that the basis for the rejections under 35 U.S.C. § 112, paragraph one, enablement, have now been obviated. Applicants therefore respectfully request that these rejections be withdrawn.

### III. Rejections Under 35 U.S.C. § 102(b)

The rejection of claims 20 and 22-25 under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 5,554,601 ("the '601 patent") has been maintained. According to the Examiner, the '601 patent discloses a method of treating a neurodegenerative disorder by administering 17 $\beta$ -estradiol. Additionally, the Examiner contends that "the mechanism by which estradiol exerts its activity has no patentable significance."

The rejection is respectfully traversed, and reconsideration is requested in view of the present amendments.

In order to expedite prosecution of the present case, and without conceding the Examiner's position or the validity of the rejection, Applicants have cancelled claims 20 and 25 without prejudice. Consequently, claims 22-23 have been amended to depend from claim 3, and claim 24 has been amended to depend from claim 1. The '601 patent does not teach methods of lowering A $\beta$  peptides *in vivo* without affecting sAPP levels. In view of the foregoing, the rejection of claims 22-24 in view of '601 is moot. Thus, it is respectfully submitted that the '601 patent does not anticipate amended claims 22-24. Accordingly, Applicants respectfully request that this rejection be withdrawn.

\* \* \* \* \*

The rejection of claims 20 and 23-25 under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 5,719,137 ("the '137 patent") has been maintained. The Examiner states that the '137 patent discloses a method of reducing the risk of AD by administering 17 $\alpha$ -dihydroequilenin, and describes an animal study in which groups of rats were treated with 17 $\beta$ -estradiol for up to three days.

The rejection is respectfully traversed, and reconsideration is requested in view of the present amendments.

As set forth above, Applicants have cancelled claims 20 and 25 without prejudice. Consequently, claims 22-23 have been amended to depend from claim 3, and claim 24 has been amended to depend from claim 1. The '137 patent does not teach methods of lowering A $\beta$  peptides *in vivo* without affecting sAPP levels. In view of the foregoing, the rejection of claims 22-24 in the context of reducing the risk of AD by administering 17 $\alpha$ -dihydroequilenin or 17 $\beta$ -estradiol is moot. Thus, the '137 patent does not anticipate amended claims 23-24. Accordingly, applicant respectfully requests that this rejection be withdrawn.

\* \* \* \* \*

The rejection of claims 1-3, 5, 6, 20, 23-25, and 31 under 35 U.S.C. § 102 as anticipated by International Publication No. WO 98/43647 ("WO '647") has been maintained. According to the Examiner, WO '647 teaches the administration of 17 $\beta$ -estradiol to reduce APP

fragments, which allegedly include A $\beta$ , and teaches methods for alleviating an impaired condition brought on by neurodegenerative or cognitive changes. *See* Office Action at pages 6-7.

The rejection is respectfully traversed, and reconsideration is requested.

As set forth above, and in order to expedite prosecution of the present case without conceding the Examiner's position or the validity of the rejection, claims 1-3, 22-24, and 31 have been amended. Claims 4, 20, and 25 have been cancelled without prejudice or disclaimer.

In view of the foregoing, the rejection of the claims 23-24, and 31 in the context of methods for alleviating an impaired condition brought on by neurodegenerative or cognitive changes is moot.

With regard to amended claims 1-3, 5, 6, 23-24, and 31, it is noted that WO '647 does not disclose methods for lowering A $\beta$  levels without affecting sAPP levels. Applicants respectfully note that according to MPEP 2131, in order to anticipate a claim, the reference must teach each and every element of the claim. Furthermore, the Federal Circuit has found that "the identical invention must be shown in as complete detail as is contained in the ... claim," *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Applicants respectfully submit that WO '647 fails to meet these requirements since it does not teach or describe Applicants' methods for lowering A $\beta$  levels in any manner, much less in the complete detail as required by Applicants' claims.

Instead, WO '647 discloses a method for treating neurodegenerative disorders by reducing **APP holoprotein expression levels and APP mRNA synthesis** through administration of estrogenic compounds, such as 17 $\beta$ -estradiol. The invention described in WO'647 relates to reducing the APP holoprotein level and that "this reduction is expected to reduce the neurotoxicity or neurodegeneration associated with APP over expression." *See*, WO '647 at page 1, lines 13-23; and also at page 6, lines 1-2 and 15-17; and page 8, lines 25-26. The essence of the invention described in WO'647 is the reduction in APP holoprotein levels by decreasing APP synthesis. The WO'647 applicants emphasize the aspects of APP holoprotein synthesis (as opposed to degradation or proteolytic processing) that they target in their statement at page 4, lines 26-30:

In contrast to the above studies, the present invention, as disclosed herein, concerns the expression, formation, or synthesis of APP.

APP holoprotein is a full-length, native peptide of 770 amino acids that has not undergone any proteolytic cleavage. APP holoproteins and APP isoforms are not A $\beta$  peptides. A $\beta$  peptides are generated by proteolytic processing of APP through  $\beta$ - and  $\gamma$ -secretase activities (See Specification at p. 1, line 11 to p. 2, line 9). WO '647 describes several APP isoforms, ranging in size from 695-770 amino acids, that are produced by differential splicing of a primary transcript of the three major APP isoforms, APP-695 (predominantly expressed in neurons), APP-751, and APP-770 (predominantly expressed in astrocytes). See WO'647 at page 3, lines 3-13. These isoforms are not A $\beta$  peptides and in particular not A $\beta$ 40 or A $\beta$ 42 peptides (which are 40 or 42 amino acids in length, respectively).

For the Examiner's convenience and reference, Applicants are providing a copy of a description of APP and Alzheimer's authored by Dr. Joe Buxbaum (a neuroscientist skilled in the art, from website: [http://www.upstate.com/features/app\\_lp.asp?c=221&r=556](http://www.upstate.com/features/app_lp.asp?c=221&r=556)), describing the relationship of APP to A $\beta$ , and the complex cleavage and regulatory processes involved in generating various APP isoforms.

Importantly, the only reference in WO '647 of any APP fragments is the hypothetical statement in the Abstract, at lines 4-5 that “[t]he reduction in the level of APP holoprotein caused by estrone or 17 $\beta$ -estradiol is also expected to reduce the production of neurotoxic APP fragments.” Nowhere in WO'647 is there any teaching of reducing A $\beta$  levels, without affecting sAPP levels.

Furthermore, a reduction of APP holoprotein is not indicative of reduced A $\beta$  levels. In fact, the present specification states that “a change in sAPP $\alpha$  levels (up or down) is a poor guide to anti-amyloid drug development”, and describes the present inventors’ surprising discovery that administration of estrogen compounds reduces A $\beta$  levels, without affecting sAPP levels (p. 7, lines 15-22). Thus, reduced APP holoenzyme levels do not necessarily correlate to reduced A $\beta$  levels.

Applicants point out that WO '647 makes no mention of A $\beta$  levels, much less the ratios of A $\beta$ 42 to A $\beta$ 40 in the context of reducing synthesis or production of APP holoenzyme; and therefore, cannot anticipate the presently claimed methods that require a reduction in A $\beta$  levels while not affecting sAPP levels. Even assuming *arguendo*, that WO '647 describes APP fragments that could encompass A $\beta$ s, reducing the *production* of APP holoenzyme does not equate with reducing A $\beta$  levels *in vivo* in an animal, without affecting soluble APP levels.

In view of the foregoing, WO '647 does not anticipate pending claims 1-3, 5, 6, 23-24, and 31 and Applicants respectfully request that this rejection be withdrawn.

**IV. Rejections Under 35 U.S.C. § 103(a)**

Claim 22 has been rejected under 35 U.S.C. § 103(a) as obvious over the '137 patent or WO '647. The Examiner acknowledges that each of these references fails to disclose administration of 17 $\beta$ -estradiol for at least 10 days, but contends that this dosing regimen would be obvious to one of ordinary skill. The Examiner also reiterates his contention that the mechanism of action of estradiol is not significant.

The rejection is respectfully traversed, and reconsideration is requested in view of the present amendments.

Claim 22 has been amended to depend from claim 1. Neither '137 nor WO '647 teaches or suggests an A $\beta$  level reducing dose of 17 $\beta$ -estradiol that does not affect soluble APP levels. Obviousness requires that each and every claim limitation be disclosed or suggested by the prior art. Neither of the cited references alone or in combination disclose or suggest the instant invention because they do not disclose or suggest, and therefore cannot render obvious the presently claimed methods that require a reduction in A $\beta$  levels while not affecting sAPP levels. Thus, these references (taken alone or in combination) do not teach or suggest the presently claimed method for reducing A $\beta$  levels *in vivo* without affecting sAPP levels.

In view of the foregoing, the rejection of claim 22 as obvious over the '137 patent or WO '647 is moot. Accordingly, Applicants respectfully request that this rejection be withdrawn.

\* \* \* \* \*

Claims 22 and 23 have been rejected under 35 U.S.C. § 103(a) as obvious over Xu et al., *Nature Medicine*, 4:447-451 (April 1998) (“Xu”). Xu is cited by the Examiner as disclosing that estradiol reduces neuronal generation of A $\beta$  peptides and is thus “clearly suggestive of delaying or preventing AD.” Office Action at p. 9. The Examiner contends that the estradiol mechanism of action has no significance.

The rejection is respectfully traversed, and reconsideration is requested.

Claims 22 and 23 have been amended to depend from claim 1. Xu does not teach or suggest an *in vivo* A $\beta$  level reducing dose of 17 $\beta$ -estradiol that does not affect soluble APP levels. Obviousness requires that each and every claim limitation be disclosed or suggested by the prior art. Xu does not disclose or suggest the instant invention because it does not disclose or suggest, and therefore cannot render obvious the presently claimed methods that require a reduction in A $\beta$  levels while not affecting sAPP levels.

Accordingly, it is respectfully requested that the claim rejections under 35 USC § 103(a) be withdrawn.

\* \* \* \* \*

Claims 1-6, 20, 22-25, and 31 have been rejected under 35 U.S.C. § 103(a) as obvious over International Publication No. WO 99/48488 (“WO ‘488”) in view of U.S. Patent No. 5,510,342 (“the ‘342 patent”), U.S. Patent No. 3,843,662 (“the ‘662 patent”) or Lundeen, *Endocrinology*, 138:1552 (1997) (“Lundeen”), individually or taken together. WO ‘488 is cited by the Examiner as disclosing methods of lowering cholesterol levels that reduce A $\beta$  production and thus decrease the risk of developing AD. Each of the other references are cited by the Examiner as disclosing the use of estrogens to lower cholesterol. According to the Examiner, it would have been obvious to use estrogens in a method of reducing the risk of AD.

The rejection is respectfully traversed, and reconsideration is requested.

As stated in the response filed July 28, 2006, none of the prior references of record, and more particularly, none of the references cited by the Examiner in the current obviousness

rejections (WO '488 in view of the '342 patent, the '662 patent or Lundein) provide any teaching or suggestion of presently claimed *in vivo* methods for reducing A $\beta$  levels with an amount of estradiol or conjugated equine estrogen composition that would exhibit the property of not affecting soluble APP levels. Importantly, the claim element cannot be ignored, as courts have repeatedly held that “[i]t is elementary patent law that all limitations are material.” *Glaxo, Inc. v. Novopharm, Ltd.*, 110 F.3d 1562, 42 USPQ2d 1257 (Fed. Cir. 1997).

The WO '488 publication discloses that cholesterol lowering drugs can reduce production of A $\beta$ . WO'488 does not teach that A $\beta$  levels can be reduced according to the present invention without affecting sAPP levels *in vivo*. Furthermore, the correlation between lowering cholesterol and A $\beta$  formation is weak at best. In particular, Applicants note that Fagan *et al.* ((2004) *American Journal of Pathology* Vol. 165, No. 4:1413; copy previously provided) showed that there were “no differences in the A $\beta$  pathology in PDAPP mice of various apoAI genotypes despite robust differences in plasma cholesterol levels between the groups” (see Fagan *et al.*, Abstract).

The deficiencies of WO '488 cannot be overcome by combining the general teachings of the '342 patent, the '662 patent, or Lundein, that merely teach the interchangability of estradiol and equine conjugated estrogen.

Furthermore, the Examiner has not provided any evidence to suggest that any of these references inherently teaches or suggests that using estradiol as claimed would exhibit the property of reducing A $\beta$  levels without affecting soluble APP levels *in vivo*. On the contrary, the only evidence of record concerning *in vivo* methods for reducing A $\beta$  levels without affecting soluble APP levels is that set forth in the present application.

The use of the disclosure of the present application (*i.e.*, *in vivo* methods for reducing A $\beta$  levels without affecting soluble APP levels as an inherent property of the claimed invention) to dismiss the objective evidence, and thereby to support the *prima facie* case for obviousness, represents an improper “hindsight” argument for obviousness. See for example, *In re Adams* 356 F.2d 998 (CCPA 1962), 148 USPQ 742. The *In re Adams* court held that it was not possible to

reject the claims as obvious based upon on hindsight arguments that the unexpected result of the claimed invention (in this case, a unexpected efficiency of heat transfer) was inherent in the claimed invention (in this case, due to the use of foam for heat transfer). In particular, the court noted: “Of course it [heat transfer] was inherent, otherwise the appellant’s invention would not work.” *In re Adams*, 356 F.2d at 1002. In concluding that the claimed invention was non-obvious, the court stated: “[T]he art does not suggest the use of foam in heat transfer of any kind and there is not the slightest suggestion that anyone knew of the existence of the inherent superiority until Adams disclosed it.” *In re Adams*, 356 F.2d at 1003.

MPEP 716.01, MPEP 712.02, MPEP 2141, paragraph III, and MPEP 2144.08, paragraph II.B. all provide that objective evidence of unexpected results, such as evidence of superiority in a property or presence of an unexpected property, must be considered by the Examiner in determining the issue of obviousness of claims for patentability under 35 USC § 103<sup>1</sup>. In particular, MPEP 2144.08, paragraph II.B., states: “Usually, a showing of unexpected results is sufficient to overcome a *prima facie* case of obviousness” (citing *In re Albrecht*, 514 F.2d 1389, 1396, 185 USPQ 585, 590 (CCPA 1975)). In the present case, the Applicants’ unexpected results are those obtained in the ovx mice treated with estradiol that had reduced Aβ levels without affecting sAPP levels.

Importantly, courts have held that “[o]bviousness cannot be predicated on what is unknown. Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection (cites omitted).” (*In re Rijckaert*, 9 F.3d 1531, 1534 (1993), 28 USPQ.2d 1955).

Therefore, none of the cited references can be relied on to reject the claims as obvious because none of them teaches or suggests an estradiol or conjugated equine estrogen composition dose that achieves the claimed result of lowering Aβ levels *in vivo* while not affecting sAPP levels.

---

<sup>1</sup> The courts have consistently held that objective evidence of non-obviousness must be considered before a conclusion of obviousness is reached. See, for example, *Gilette v. S.C. Johnson*, 919 F.2d 720, 16 USPQ.2d 1923; *Knoll v. Teva*, 367 F.3d 1381, 70 USPQ.2d 1957; and *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021.

In view of the foregoing, claims 1-6, 20, 22-25, and 31 are not obvious over WO '488 in view of the '342 patent, the '662 patent or Lundein. Accordingly, Applicants respectfully request that this rejection be withdrawn.

\* \* \* \* \*

Claim 4 has been rejected under 35 U.S.C. § 103(a) as obvious over WO '647 in view of the '601 patent. WO '647 discloses a method for treating neurodegenerative disorders by reducing APP holoprotein levels using 17 $\beta$ -estradiol. The '601 patent is cited by the Examiner as teaching the equivalence of 17 $\beta$ -estradiol and conjugated equine estrogen, as called for in claim 4. According to the Examiner, it would have been obvious to replace 17 $\beta$ -estradiol with conjugated equine estrogen in view of these references.

The rejection is respectfully traversed, and reconsideration is requested.

Claim 1 has been amended to incorporate the subject matter of claim 4, and claim 4 has been cancelled without prejudice or disclaimer. Thus, the rejection of claim 4 would apply to amended claim 1. As set forth in detail above, neither WO '647 nor the '601 patent discloses A $\beta$  levels.

Obviousness requires that each and every claim limitation be disclosed or suggested by the prior art. None of the cited references alone or in combination disclose or suggest the instant invention because they do not disclose or suggest, and therefore cannot render obvious the presently claimed methods that require a reduction in A $\beta$  levels while not affecting sAPP levels. Thus, these references (taken alone or in combination) do not teach or suggest the presently claimed method for reducing A $\beta$  levels *in vivo* without affecting sAPP levels.

In view of the foregoing, claim 4 is not obvious over WO '647 in view of the '601 patent. Accordingly, Applicants respectfully requests that this rejection be withdrawn.

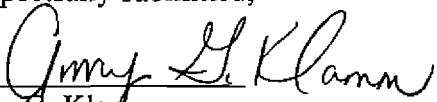
Conclusion

In view of the above amendments and remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining that the Examiner believes can be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: February 15, 2007

Respectfully submitted,

By   
Amy G. Klann

Registration No.: 48,155  
DARBY & DARBY P.C.  
P.O. Box 5257  
New York, New York 10150-5257  
(212) 527-7700  
(212) 527-7701 (Fax)  
Attorneys/Agents For Applicant